



Pre-Appeal Brief Request for Review
Dated: October 23, 2007

Customer No.: 00909

Applicant: TSO
Serial No: 09/854,423
Filing Date: May 10, 2001
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE PATENT Michael M. TSO
APPLICATION OF:

SERIAL NO.: 09/854,423
ATTORNEY DOCKET 031792-0311553
NO:

FILING DATE: MAY 10, 2001
ART UNIT : 3691
EXAMINER THU THAO HAVAN

FOR: USING CURRENCY TO PURCHASE FROM SELLERS THAT DO NOT RECOGNIZE THE
CURRENCY

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Final Office Action mailed **May 23, 2007** (hereinafter "Final Action"), Applicant requests a review of the Final Rejection in the above-referenced application. This request is being filed concurrently with a Notice of Appeal.

The review is requested for the reasons set forth in the **Remarks** beginning on page 2 of this paper.

A total of 5 pages are provided.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and are hereby authorized to be charged to our Deposit Account No. 033975 (**Ref. No. 031792-0311553**).

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REMARKS

Claims 1, 3-15, 17-29, and 31-41 are pending in this application, and stand rejected under 35 U.S.C. § 103(a). Claims 42-59 are withdrawn from consideration. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Review is requested for the rejection of claims 1, 3-15, 17-29, and 31-41 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,061,660 to Eggleston *et al.* ("Eggleston") in view of U.S. Patent No. 4,968,873 to Dethloff *et al.* ("Dethloff") [Final Action, pg. 4]. Applicant traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

In the Final Action, the Examiner alleges that all of the features of independent claims 1, 15, and 29 are taught by Eggleston, with the *exception* of the feature of processing the transaction using the amount of second currency associated with the first participant [Final Action, pgs. 4-5]. The Examiner relies on Dethloff, however, to cure this admitted deficiency of Eggleston. Assuming arguendo that it were even proper to modify Eggleston to include the teachings of Dethloff in the manner alleged by the Examiner (which Applicant does *not* concede), the rejection would still be improper for at least the reason that neither Eggleston nor Dethloff, either alone or in combination, teach or suggest all of the features of independent claims 1, 15, and 29.

In particular, independent claim 1 recites, *inter alia*, the features of:

receiving, from a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction, wherein the first currency comprises a private currency;

Independent claims 15 and 29 include similar recitations. Neither Eggleston nor Dethloff, either alone or in combination, teach or suggest *at least* the foregoing features.

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In the Final Action, for the rejection of each of independent claims 1, 15, and 29, the Examiner relies upon the following passages of Eggleston: (1) col. 44, lines 40-49; (2) col. 44, line 64 → col. 45, line 67; (3) col. 15, lines 1-56; and (4) col. 46, lines 4-55. Based on the cited passages, it appears as though the Examiner is relying on Eggleston's disclosure of a consumer presenting a card to a retailer to redeem an award or prize acquired through an incentive program provided by a sponsoring entity to teach the foregoing claim recitation. Applicant disagrees. The alleged transaction in Eggleston of a user redeeming an award or prize does not constitute a transaction involving a *first currency*, whether private or otherwise, that is *not* recognized by a second participant. By contrast, Eggleston appears to disclose that this "transaction" merely concerns verification by a retailer that a particular award or prize is associated with the particular consumer claiming the award or prize:

At a step 608 the consumer is instructed **to visit a retailer to obtain a prize. The consumer presents the card 11 or a promotional item at a step 610. The retailer dials the winner's database at a step 612, inputs the card ID number at a step 614, and determines a match at a step 616.** In the absence of a match at the step 616, the retailer checks the input at a step 618 and, still failing a match, refers the consumer to the issuer at a step 620. If a match occurs at the step 616, the retailer inputs the stock keeping unit number, or SKU at a step 622 and queries the consumer database for a match at a step 624. Absent a match after checking for correct input at a step 626, the retailer refers the consumer to the issuer at a step 628. If a match occurs, the retailer receives an authorization code online or by phone from the host system at a step 630. The retailer then provides a receipt at a step 632 that is signed by the consumer, **in which case the consumer may then exit the store with the award.**

[Eggleston, col. 44, line 64 – col. 45, line 13, **emphasis added**].

...

From the consumer perspective, at a step 696, the consumer is issued a card. The consumer wins a promotion at a step 698 and is instructed, at a step 700 to retrieve the prize. At a step 702, the consumer collects the prize and, at a step 704,

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presents the prize to the retailer for fulfillment, at which point the retailer verifies and awards the prize at the steps 684 and 686.

[Eggleston, col. 46, lines 55-61].

Thus, an award redemption transaction between a consumer and retailer in Eggleston does not appear to entail an exchange of currency (private or otherwise) between the consumer and retailer that the retailer does not recognize.

Dethloff fails to cure this deficiency of Eggleston. In particular, Dethloff discloses a smart card or "M-card" which carries a program mechanism and central processing unit for manipulating values which can be stored in the card. While Dethloff does disclose functionality associated with the conversion of various national currencies (*e.g.*, Franks, Yen, Pound Sterling, or Deutschmarks) [Dethloff, *e.g.*, col. 7, lines 9-11; and FIGS. 11-12], Dethloff does not appear to disclose, teach, or suggest the feature of receiving, from a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction, wherein the first currency comprises a private currency.

In the Final Action (at pgs. 2-3), and in response to the foregoing arguments, the Examiner again cites to col. 44, line 64 - col. 45, line 67 and col. 15, lines 1-56 of Eggleston as allegedly teaching the foregoing claim features. As noted above, the foregoing passages appear to teach the prize verification or award redemption "transaction" in Eggleston that occurs between the consumer and retailer. This transaction, which concerns verification by a retailer that a particular award or prize is associated with the particular consumer claiming the award or prize, does *not* constitute a transaction involving a *first currency*, whether private or otherwise, that is *not* recognized by a second participant.

For at least the foregoing reasons, neither Eggleston nor Dethloff, either alone or in combination, appear to disclose, teach, or suggest all of the features of at least independent claims 1, 15, and 29. Accordingly, withdrawal of the rejection of independent claims 1, 15, and 29 is earnestly sought. Dependent claims 3-14, 17-28, and 31-41 are

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allowable at least because they depend from allowable independent claims, as well as for the further features they recite.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: October 23, 2007

Respectfully submitted,

By:



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